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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,976	02/15/2002	Xiangxin Bi	2950.18US02	1411

7590 04/26/2005

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EXAMINER

LE, HOA T

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/076,976	BI ET AL	
	Examiner	Art Unit	
	H. T. Le	1773	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 11 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 18-30.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment (Detailed Advisory Action).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


H. T. Le
Primary Examiner
Art Unit: 1773

DETAILED ADVISORY ACTION

1. Claims 18-30 are rejected under 35 U.S.C. 112, first paragraph for reasons set forth in the last office action and further discussed below.

In the final action, the Examiner required Applicants to include in the claims the 'Van der Waals force' and/or "electromagnetic forces" that cause the particles to "loosely agglomerate" to obviate the rejection regarding the enabling scope of the instant disclosure because that is the ground that Applicants initially argued as the support of the term "loosely agglomerated". Applicants refused to do so and argued that there are "no" other forces. If there are no other forces besides electromagnetic forces that would cause the formation of "weak agglomerates" as asserted by Applicants, then adding this feature (i.e. electromagnetic forces") in the instant claims would not affect the scope of the claimed invention. Why do Applicants adamantly refuse to include the electromagnetic forces in the claims?

2. Applicants further argued that "the enablement requirement simply only required the enablement of the claimed invention". The issue is not whether or not the specification is enabling. The issue here is the scope of the claims; that is, whether the claims are commensurate to the enabling scope of the specification. They are not. As stated in the specification, the titanium dioxide particles form "loose agglomerates" as a result of 'van der Waals' and "other electromagnetic forces" between nearby particles of small size (page 18, lines 1-2). Therefore, the claims must include the forces disclosed in the specification for them to be commensurate to the enabling scope of the disclosure. If there are no other forces besides the forces disclosed in the specification that would cause the particles to

become “loosely agglomerated”, why Applicants have such difficulty to comply to this requirement?

3. Claims 22 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiederhoft et al for reasons set forth in the previous office action and further discussed below.

Applicants now argue that the method disclosed in the Wiederhoft patent does not produce titanium oxide particles but rather “titanic [sic] hydroxide”. The teaching of the Wiederhoft reference has been discussed at length by the Examiner in the previous office actions. Therefore, it would be redundant to reiterate it here. The examiner would like to call Applicants’ attention to this passage in the Wiederhoft patent. At col. 1, lines 5-12, it reads, “the present invention relates to nanodisperse titanium dioxide, to a process for the production thereof, . . . For the purposes of the present invention, nanodisperse titanium dioxide is taken to be rutiles, anatase and amorphous titanium dioxide having particle size of 1-100 nm ...” (emphases added). Clearly, the Wiederhoft patent states that its invention is titanium dioxide particles and method of making those particles. However, Applicants argue that the Wiederhoft patent does not teach what it has disclosed (i.e. titanium dioxide particles) but rather something else (i.e. “hydrated titanium hydroxide sol”). If the Examiner agreed with Applicants’ assertion, then it would be equivalent to invalidate the Wiederhoft patent. Neither the Examiner nor the Office has the authority to declare a patent invalid based on Applicants’ arguments when all US patents are entitled to presumption of validity.

4. Applicant's arguments filed April 11, 2005 have been fully considered but they are not persuasive for reasons set forth above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le
Primary Examiner
Art Unit 1773